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No. 377

IN THE SUPREME COURT OF THE UNITED STATES

BENJAMIN ARTHUR BOURNE,
Petitioner,

versus

LUTHER JONES,
Respondent.

PETITION FOR WRIT OF CERTIORARI
(With Brief Annexed)

TO THE CIRCUIT COURT OF

APPEALS FOR THE FIFTH CIRCUIT

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IN THE SUPREME COURT OF THE UNITED STATES

BENJAMIN ARTHUR BOURNE,

Petitioner,

—vs—

LUTHER JONES,

Respondent.

PETITION FOR WRIT OF CERTIORARI

To The Honorable The Chief Justice and Associate Justice of the Supreme Court of the United States:

Your petitioner, Benjamin Arthur Bourne, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the Fifth Circuit, to review a judgment of that Court entered June 30, 1953. A transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in accordance with the Rules of this Court.

SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED

Petitioner by this petition seeks to bring before this Court for review a decision of the Circuit Court of Appeals for the Fifth Circuit, affirming an opinion and judgment of Judge Whitehurst in the District Court for the Southern District of Florida, in a suit for infringements of plant patents for sugar cane, holding invalid certain patents owned by petitioner

on the grounds of prior public use for more than two years before the filing dates of the applications upon which the patents issued and on the ground that patentee was not the sole inventor but a joint inventor with one Stevens. Judge Whitehurst held, and the Circuit Court of Appeals for the Fifth Circuit affirmed, that United States Code, Title 35, Section 69 (R.S. 4920), requiring defendant to give plaintiff notice in writing 30 days before trial the names and addresses of alleged prior users and inventors, in the absence of which evidence cannot be offered on these defenses, was no longer the law but was superseded by the Rules of Civil Procedure for the District Courts. Other Circuit Courts of Appeal have held that the Code provision is still the law since the effective date of the said Rules of Civil Procedure for the District Courts. (Blanchard v. J. L. Pinkerton, Inc., C.C.A. 9th, 173 F.2d 573; Crosley Corporation v. Westinghouse Electric and Mfg. Co., C.C.A. 3rd, 152 F. 2d 895; Bank v. Rauland, C.C.A. 7th, 146 F. 2d 19; Minnesota Mining and Mfg. Co., C.C.A. 7th, 168 F. 2d 7, Cert. denied 69 S. Ct. 56; Charles Bloom v. Titus Blatter and Co., C.C.A. 2d, 1 Fed. Rules Service 12e24 Case 4; Turini v. Allen Mfg. Co., C.C.A. 1st 198 F. 2d 491.)

The Honorable Judge Whitehurst held, and the Circuit Court of Appeals for the Fifth Circuit affirmed, that there was prior public use in the absence of any specimen, exhibit or description of the alleged prior use article offered at trial. Other Circuit Courts of Appeal have held that there must be concrete visible proof of a contemporaneous nature to establish prior public use beyond a reasonable doubt as required. (Emerson & Norris Co. v. Simpson Bros., C.C.A. 1st, 202

Fed. 747; Brooks v. Sacks, C.C.A. 1st, 81 Fed. 403; Mast, Foos & Co. v. Dempter Mill Mfg. Co., C.C.A. 8th, 82 Fed. 327; Peerless Roll Leaf Co. v. H. Griffin & Sons Co., C.C.A. 2nd 29 F. 2d 646.)

The Honorable Judge Whitehurst held, and the Circuit Court of Appeals for the Fifth Circuit affirmed, that Stevens was a joint inventor with patentee, in the absence of a showing of determination of any taxonomic or morphological characters of the patented varieties of sugar cane, by Stevens, but in the face of Stevens' avowed statements that he did not determine any of the taxonomic or morphological characteristics and did not claim to be an inventor. Other Circuit Courts of Appeal have held that there must be a working together with each contributing for joint inventorship. (Pointer v. Sixwheel Corp., C.C.A. 9th, 177 F. 2d 153.)

The Honorable Judge Whitehurst held, and the Circuit Court of Appeals for the Fifth Circuit affirmed,, that there was prior public use, in the face of uncontroverted testimony of all witnesses that patentee filed applications for patents in the minimum time required to determine characteristics thereof by actual requisite tests from the seedling stage, i. e., 5 years; and the tests by patentee were necessary and conducted under a tri-party agreement of secrecy forbidding disclosure to others. Other Circuit Courts of Appeal have held that tests necessary to determine the characteristics of the thing patented is not public use, and a breech of trust by one during such time of the tests would not invalidate a patent. (Peerless Roll Leaf Co. v. H. Griffin & Sons Co., C.C.A. 2nd,

29 F. 2d 646; Reichel v. Dorset, 49 App. D.C. 198, 262 Fed. 652.)

The sugar cane industry of the continental United States is exclusively in the territory of Circuit Court of Appeals for the Fifth Circuit, and the particular varieties of sugar cane covered by the patents in question were bred for the Everglades Region of Florida; it is, therefore, improbable, if not impossible, that litigation in other Circuits, resulting in a conflict of decisions on the validity of the particular patents, would be likely to occur.

BASIS OF JURISDICTION

The discretionary power of this Court to grant a writ of certiorari is invoked upon the following grounds as set forth in Rule 38(5) of the Rules of this Court and decisions of this Court:

1. The decision of the Circuit Court of Appeals for the Fifth Circuit is in conflict with decisions of various other Circuit Courts of Appeal on the same question as to the state of the law of United States Code, Title 35, section 69 (R.S. 4920).

2. The decision of the Circuit Court of Appeals for the Fifth Circuit is in conflict with the decisions of other Circuit Courts of Appeal on the same question of law as to degree of proof required to invalidate a patent.

3. The particular patents involved dominate an industry concentrated in the territory of the Circuit Court of Appeals for the Fifth Circuit so that litigation in other Circuits resulting in a conflict of decisions is unlikely. (Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126; Muncie Gear Works, Inc. v. Outboard Marine and Mfg. Co., 315 U. S. 759.)

QUESTIONS PRESENTED

I.

Was United States Code, Title 35, Section 69 (R. S. 4930), a valid law on July 31, 1950?

II.

In the absence of notice as required by United States Code, Title 35, Section 69 (R. S. 4920), are the defense of invalidity of patents on the grounds enumerated in said law available to defendant over objection of plaintiff?

III.

In the absence of a specimen, exhibit or description of an alleged prior public use article, has a defendant met the burden of proof to sustain a defense of prior public use?

IV.

In the absence of evidence of a jointly working together and sharing jointly contributing to a development, but on affirmative showing that only one determined and developed the article, can there be joint inventorship?

V.

Is there prior public use within the meaning of the patent statutes during the time patentee must test his invention to determine the characteristics thereof and its utility under service conditions before it can be described or before anyone in the art would purchase it?

REASON RELIED ON FOR ALLOWANCE OF THE WRIT

1. That the Circuit Court of Appeals for the Fifth Circuit in holding the Bourne Plant Patents Numbers 203, 210 and 220 invalid because of prior public use and Bourne not sole inventor, in the absence of 30 days' notice as required by U. S. Code Title 35, section 69 (R. S. 4920) and over objection of plaintiff-appellant, on the holding that said code provision was no longer the law, has rendered a decision in conflict with the decisions of the Circuit Courts of Appeals for the First, Second, Third, Seventh and Ninth Circuits, on the same matter, in Blanchard v. J. L. Pinkerton, Inc., C.C.A. 9th, 173 F. 2d 573; Crosley Corporation v. Westinghouse Electric and Mtg. Co., C.C.A. 3rd, 152 F. 2d 895; Bank v. Rauland, C.C.A. 7th, 146 F. 2d 19; Minnesota Mining and Mfg. Co., C.C.A. 7th 168 F. 2d, Cert. denied 69 S. Ct. 56; Charles Bloom v. Titus Blatler and Co., C.C.A. 2nd, 1 Fed. Rules Service 12e24 Case 4; Turini v. Allen Mfg. Co., C.C.A. 1st, 198 F. 2d 491.

2. That the Circuit Court of Appeals for the Fifth Circuit, in holding Bourne Plant Patents Numbers 203, 210 and 220 invalid because of prior public use in the absence of an exhibit, specimen or description of the alleged prior use article, has rendered a decision in conflict with the decisions of the Circuit Courts of Appeals for the First, Second and Eighth Circuits on the same matter, i. e., degree of proof to invalid a patent, in Emerson & Norris Co. v. Simpson Bros., C.C.A. 1st, 202 Fed. 747; Brooks v. Sacks, C.C.A. 1st, 81 Fed. 403; Mast, Foos & Co. v. Dempter Mill Mfg. Co.,

C.C.A. 8th, 82 Fed. 327; Peerless Roll Leaf Co. v. H. Griffin & Sons Co., C.C.A. 2nd 29 F. 2d 646.

3. The Circuit Court of Appeals for the Fifth Circuit in holding Bourne Plant Patents Numbers 203, 210 and 220 invalid on the grounds that Bourne was not the sole inventor, in the absence of a showing of any taxonomic or morphological characteristics being determined by another, and in the face of a clear denial by the alleged co-inventor that he determined any of the characteristics or was an inventor, is in conflict with the decisions of the Circuit Court of Appeal for the Ninth Circuit on the same matter, i. e., sole and joint inventions, in Pointer v. Sixwheel Corp., C.C.A. 9th, 177 F. 2d 153, section B, on page 157.

4. The Circuit Court of Appeals for the Fifth Circuit, in holding the Bourne Plant Patents Numbers 203, 210 and 220 invalid on prior public use within the time required for patentee to test and determine the characteristics of the plants under agreement of secrecy, is in conflict with the decisions of the Circuit Court of Appeals for the Second Circuit and the District of Columbia on the same matter, i. e., prior public use within the meaning of the patent statutes, in Peerless Roll Leaf Co. v. H. Griffin and Sons Co., C.C.A. 2d, 29 F. 2d 646; Riechel v. Dorset, App. D.C., 262 Fed. 652.

5. The Sugar Cane industry is concentrated in the territory of the Circuit Court of Appeals for the Fifth Circuit, so that litigation in other Circuits resulting in a conflict of decisions would not be likely to occur (Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126).

THE IMPORTANCE OF THE CASE

The Bourne Sugar Cane Patents are the basic patents upon which the sugar cane industry of Florida was founded and exists today. This industry involves many millions of dollars a year. In that industry, petitioner has an important interest.

The present litigation is but one of many suits in the same district between petitioner and infringers. The outcome of this case will control the other cases and the numerous other defendants.

Moreover, the Circuit Court of Appeals for the Fifth Circuit has deprived Bourne of the fame of having been the sole inventor of an invention of primary commercial and scientific importance.

Wherefore, your petitioner respectfully prays that a Writ of Certiorari be issued under the seal of this Court, directed to the United States Circuit Court of Appeals for the Fifth Judicial Circuit, sitting at New Orleans, Louisiana, commanding said Court to certify and send to this Court on a day to be designated, a full and complete transcript of the record and all proceedings of the said Circuit Court of Appeals had in this cause and all exhibits filed therein, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals be reversed, and that petitioner be granted such other and further relief as may seem proper.

Dated, West Palm Beach, Florida, September 8, 1953.

HAL H. McCAGHREN,
Attorney for Petitioner

STATE OF FLORIDA
COUNTY OF PALM BEACH } SS

Hal H. McCaghren, being duly sworn, deposes and says that he is attorney for petitioners herein; that he prepared the foregoing petition and that the allegations thereof are true as he verily believes.

HAL H. McCAGHREN

Subscribed and sworn to before me this 8th day of September, 1953.

(SEAL)

ETHEL GROSS,
Notary Public

IN THE SUPREME COURT OF THE UNITED STATES

BENJAMIN ARTHUR BOURNE,

Petitioner,

—vs—

LUTHER JONES

Respondent.

BRIEF ON BEHALF OF PETITIONER

This is a brief on behalf of Petitioner for Writ of Certiorari with Brief Annexed.

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JURISDICTION

Jurisdiction is involved under discretionary powers of this Court set forth in Rule 38(5) of the Rules of this Court and decisions of this Court:

1. Conflict of decision of the Circuit Court of Appeals for the Fifth Circuit with decisions of other Circuit Courts on the question of the validity of United States Code Title 35, Section 69 (R.S. 4920), on July 31, 1950.

2. Conflict of decision of the Circuit Court of Appeals for the Fifth Circuit with decisions of other Circuit Courts on the law of degree of proof required to invalidate a patent.

3. The particular patents involved dominate an industry wholly located in territory of the Circuit Court of Appeals for the Fifth Circuit so that litigation resulting in conflict of decisions is unlikely.

STATEMENT OF THE CASE

The Petitioner was Plaintiff-Appellant, below, Respondent was Defendant-Appellee. They will be referred to herein as Plaintiff and Defendant respectfully. The Transcript will be cited by page numbers in parenthesis, to-wit: (Tr. 1).

Plaintiff filed his complaint against Defendant for patent infringement of his United States Plant Patents, numbers 203, 210, and 220, and prayed for injunction, acounting, punitive damages, costs, and general relief. Plaintiff amended his complaint to add thereto copy of written notice of infringement to Defendant, and copies of the said patents (Tr. 1-9).

Defendant filed his Defense on Merits, admitting jurisdiction of the Court over the subject matter and the parties

and that Defendant has planted, cultivated and harvested the sugar canes described in the patents; but denying ownership of the patents by Plaintiff, and alleging the patents to be invalid, and the Plant Patent Statute to be unconsitutional (Tr. 9-13).

On July 26, 1950, only 4 days prior to trial, Defendant filed his Defense Specification, attempting to give Notice pursuant to Title 35, section 69, U. S. Code (Tr. 13-20).

On July 31, 1950, trial by the Court without a Jury was started, and resumed August 1, 2, 3, 4, 7, 8, 9, 10, 11, 1950; and, on August 11, 1950, the Court took the case under advisement pending filing of briefs (Tr. 21).

At trial Plaintiff proved ownership of the three patents and the infringement of each, which was admitted by Defendant.

Plaintiff further proved at the trial that he envisioned and conceived that the particular cross of parents he employed would result in many progeny, at least one individual of each cross would have the properties he sought. Accordingly, he had a parcel of land set aside by his employer, Southern Sugar Company, as a breeding plot for him. This plot was fenced, drained and equipped for irrigation. Plaintiff planted the parents, that he proposed to cross, in adjacent rows to facilitate cross-pollination; at the proper time he cross-pollinated the parents, collected the resultant seed, dried and planted the seed, selected the seedlings obtained and planted them in the field. The seedlings, by planting in the field, was first asexually reproduced to form a stool of many stalks. From these thousands of stools, Plaintiff made his first selections based on observations and tests. Plaintiff then

started the laborious task of extending, and testing these seedlings he had selected and given a number. As the extensions and tests progressed many varieties were eliminated until after the 1935-36 harvest and first full commercial mill run tests were evaluated and the three varieties selected, from the characteristics then ascertained, to be patented. All this work and tests were verified by the Plaintiff, independent witnesses, and contemporaneous documents.

All qualified expert witnesses appearing at the trial testified that at least five years of testing are required subsequent to the seedling stage to ascertain the characteristics of a new sugar cane variety; and a full commercial mill test run results would have to be known before they would use a new sugar cane variety commercially (Tr. 197, 198, 334, 339).

During a part of the time of these laborious tests, Plaintiff held dual employment, one employer being the Southern Sugar Company and its sucessors, and the other being the Everglades Experiment Station. There was during this period of time a tri-party agreement in effect between the Everglades Experiment Station, the Sugar Company, and the U. S. Department of Agriculture's Bureau of Plant Industry, to assist each other in testing new varieties of sugar cane (Tr. 335) (Defendant's Exhibits 7, 8). Plaintiff, accordingly, gave a portion of the seed pieces of these thousands of new varieties to Everglades Experiment Station, one of his employers, for soil testing; but, after ascertaining that other employees of the Experiment Station had failed to keep the varieties properly segregated so that the results of their tests could not have any scientific value, he continued all tests alone on Sugar Company land.

Defendant started to offer testimony of prior public distribution by Everglades Experiment Station, Plaintiff objected on the grounds that notice 30 days before trial was not given pursuant to R. S. 4920; U. S. Code, Title 35, Section 69 (Tr. 63, 183, 370). The Court ruled that this Statute was superseded by The Rules of Civil Procedure, and admitted oral testimony of prior public distribution, without corroboration of samples or description of the sugar canes received.

All witnesses called on prior public distribution admitted that the canes they had received were first experimented with to determine some of the characteristics, and not placed in use until approximately the time patent applications were filed (Tr. 185, 236, 237).

The witnesses, when confronted with contemporaneous documents, admitted their memory was wrong, and that they could not remember that many years back (Tr. 186). (Plaintiff's Exhibit 6).

Mr. Stevens, Agronomist at Everglades Experiment Station, to whom Plaintiff had given portions of the seedlings for testing, testified that he only made some sugar tests of the canes and split a stalk; and, that he didn't claim to be the inventor (Tr. 302, 303).

The Court on July 24, 1951, entered its opinion holding the patents invalid on prior public use, and also because Plaintiff was not the sole inventor but a joint inventor with Stevens (Tr. 21-34).

On August 3, 1951, Plaintiff filed motion for rehearing, amendment and correction of findings of facts and conclusions of law, and for supplemental findings of fact and conclusions of law. (Tr. 35-59). In this motion Plaintiff set

forth with specificity wherein the evidence was contrary to the findings and the law was misapplied or misapprehended by the Court.

On July 2, 1952, the Court entered ts order denying Plaintiff's motion, pro forma (Tr. 62).

Plaintiff entered and perfected his appeal to the Circuit Court of Appeals for the Fifth Circuit as set forth in the Statement of Points on Appeal (Tr. 67-74) on the grounds there set forth specifically, but generally alleging there was no evidence to support the findings, the findings were contrary to the facts, the ruling of the Court was contrary to the law, and the conclusions of law were contrary to the facts and law. The Circuit Court affirmed the District Court and denied rehearing. This Petition was duly filed to The Supreme Court.

ASSIGNED ERRORS

1. The Courts below erred as a matter of law in holding United States Code, Title 35, Section 69 (R. S. 4920) superseded by the Rules of Civil Procedure for District Courts.

2. The Courts below erred as a matter of law in holding Plant Patents Numbers 203, 210 and 220 invalid on the grounds of prior public use and patentee not sole and first inventor, in the absence of 30 day notice required by United States Code Title 35, Section 69 (R. S. 4920), and over objection of plaintiff.

3. The Courts below erred as a matter of law in holding that there was a joint invention of Plant Patents numbers 203, 210, and 220.

4. The Courts below erred as a matter of law in holding that there was prior public use within the meaning of the

patent Statutes of the subject matter covered by Plant Patents numbers 203, 210 and 220.

ARGUMENT

SUMMARY

The law is well established that failure of Defendant to give 30 days notice prior to trial as required by R. S. 4920; U. S. Code, Title 35, section 69, bars the affirmative defenses there enumerated, including the defenses of prior public use and patentee not sole inventor.

The undisputed evidence, particularly the contemporaneous documentary evidence and admissions of Stevens, clearly shows that Plaintiff alone bred, asexual reproduced, and determined the characteristics of the patented varieties within the minimum time set by the experts to determine these characteristics.

The record is noticeably lacking any specimen, drawings, exhibits or description by characteristics of any plants alleged to invalidate by prior public use; in the absence of which, under the law, proof of public use is too unreliable to form a safe basis for judicial action.

WHEREFORE, it is confidently submitted that the Opinion of the District Court and Final Judgment entered thereon for Respondent and against Petitioner, and affirmed by the Circuit Court, should be reversed, with directions to the Circuit Court to order District Court to enter Opinion and Judgment for Petitioner and against Respondent holding United States Plant Patent Numbers 203, 210 and 220 valid and infringed, and order accounting of the Respondent for profit and damages, enter injunction against further infringement by Res-

pondent, and assess costs against Respondent.

ASSIGNED ERROR 1 AND 2

The law is well settled that Defendant's failure to give written notice, at least 30 days before trial of patent infringement suit, that the invention of the patent had been in public use for more than two years prior to patentee filing his application, or that patentee was not the first and sole inventor, as required by the statute, barred such defenses.

The Statute, Title 35, Section 69, states " . . . the defendant . . . , having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

" . . . Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the things patented; or

" . . . Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

"And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state . . . the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; . . . "

Blanchard v. J. L. Pinkerton, Inc., D. C. S. D. Calif. 77 F.S. 861, affirmed C.C.A. 9th, 173 F. 2d 573 (May 13, 1948) held: "In patent infringement suit, use of structure which was not pleaded as defense could not be considered as anticipation. 35 U.S.C.A.) 69, subd 5. The use of the 1932 structure was not pleaded as a defense, and cannot be con-

sidered as anticipation. 35 U.S.C.A. 69 (5); and see Electric Storage Battery Co. v. Shimadzu, 1930, 307 U.S. 5, 17, 59 S. Ct. 675, 83 L. ed. 1071."

Crosley Corp. v. Westinghouse Electric and Mfg. Co., D. C. Pa., 52 F.S. 884, affirmed C.C.A. 3rd, 152 F. 2d, 895, held: "The prior art patents and publications and the alleged instances of prior knowledge and use which were not pleaded in plaintiff's reply to the counterclaim herein, or otherwise noticed at least thirty days prior to the trial, against any particular patent in suit, as required by R S. (4920, 35 U.S.C.A.) 69, cannot be urged for purposes of anticipating or invalidating such patent."

Banks v. Rauland, C.C.A. 7th, 146 F. 2d 19 (Dec. 20, 1944) held: "Those findings are based upon prior art which was not pleaded, and it would be error to consider them on the question of anticipation or novelty. In conclusion, we affirm the district court's decision as to non-infringement, and as to invalidity of the claims because they are not sufficiently specific under the statute. As to the court's holding that the patent is invalid for any other reason, the decree is reversed."

Minnesota Mining & Mfg. Co. v. Industrial Tape Corp., C.C.A. 7th, 168 F. 2d 71 (May 6, 1948), cert. denied, 69 S. Ct. 56, stated: "In the first place, we must notice the contention that the McCarthy device was improperly relied upon by the defendant and the court because it was not pleaded by the defendant. It is asserted that the defense of anticipation must be pleaded or noticed, as required by Title 35 U.S.C.A., Sec. 69. The record discloses that these prior art devices of the plaintiff were exhibited and explained to the court by plaintiff's counsel in his opening statement and

that they were offered and introduced into the record by plaintiff. It perhaps is true, as asserted by plaintiff, that they were offered only for the purpose of showing the prior state of the art, and that such unpleaded devices can not properly be relied upon to show anticipation. Oswell v. Bloomfield et al., 7 Cir., 113 F. 2d 377, 378; Bank v. Rauland Corp., et al, 7 Cir., 146 F. 2d 19, 23; Hendy v. Golden State & Miners' Iron Works, 127 U.S. 370, 375, 8 S.Ct. 1275, 32 L.Ed. 207."

Charles Bloom, Inc., v. Titus Blatler & Co., Inc., C.C.A. 2nd, 1 F.R.S. 12e24 Case 4, held: "Plaintiff's request that defendant specify the number and dates and patentees of the patents referred to in the answer and the names of the countries in which they were secured, is denied without prejudice for the reason that the defendant must give this information 30 days before the trial, otherwise he cannot offer proof on the trial. Title 35, U.S.C.A. Sec. 69."

Turini v. Allen Mfg. Co., C.C.A. 1st, 198 F. 2d 491, also holds that United States Code, Title 35, Section 69, must be complied with or the defenses are not available to defendant.

ASSIGNED ERROR 3

The record clearly establishes that plaintiff-appellant determined all the characteristics of these canes alone. Stevens admits that he made only Brix and Sucrose determinations on canes, and doesn't even identify these canes by morphological characters (Tr. 39-40, 296, 302-3).

The law is well stated in Pointer v. Sixwheel Corp., 177 F. 2d 153, section B, page 157.

"To the contrary joint invention implies, as Robinson says, that two or more inventors agree "that a result, if it could be achieved, would be desirable, neither as yet having attempted to provide a means, and from this point go forward by mutual consultations and suggestions."

"And the product of the joint endeavor is a joint invention when, as the same author puts it, "before the entire conception of the invention by one inventor, another meets him and by his consent unites with him in exercising inventive skill upon the development and perfecting of the conception." 1 Robinson on Patents, p. 567.

"Here, there is no voluntary pooling of ideas."

ASSIGNED ERROR 4

The record clearly establishes that plaintiff-appellant filed applications for patents within 5 years from the seedling stage, which is the minimum period of time to conduct requisite tests for characteristics; and that the tri-party agreement forbade disclosure to others—i. e., it was secret revelopment. (Tr. 185, 186, 197, 198, 236, 237, 251, 258, 334, 339). Peerless Roll Leaf Co. v. H. Griffin & Sons, 29 F. 2d 646.

No specimen, exhibit or description of alleged prior use article was offered at trial.

The law is well settled that prior public use must be established not merely by testimony of witnesses, but by concrete, visible proof of a contemporary nature.

Mast, Foos & Co. v. Dempter Mill Mfg. Co., C.C.A. 8th, 82 Fed. 327, held:

"In considering the merits of the case, the defenses of prior use and no utility may be dismissed without extended

consideration. All the witnesses on both sides of the case testify that the combination of the internal-toothed spur-wheel with the pinion and the other usual machinery of a windmill and pump is more useful and more valuable than any other combination of elements in a windmill and pump yet discovered. The evidence of prior use is the testimony of a single witness, who was once in the employ of another infringer of the device of the appellant, but has since been employed by the appellee. He produces no part of the old windmill which he testifies was set up and put in operation before Martin filed his application, and his evidence is without the support of any patents or exhibits, and without the support of the testimony of any other witness. The unsupported oral testimony which will warrant a finding of prior use should be clear and satisfactory. It is always open to suspicion. It ought to be sufficient to establish such a use beyond a reasonable doubt. The Barbed-Wire Patent, 143 U. S. 275, 12 Sup. Ct. 443, 450; Deering v. Harvester Works, 155 U. S. 286, 300, 15 Sup. Ct. 118. The testimony for the appellee on this issue is not of this character, and it will be dismissed without further comment."

Peerless Roll Leaf Co. v. H. Griffin & Sons Co., C.C.A. 2nd, 29 F. 2d 646, held:

"The cases nearly always also raise the question whether the invention is in process of experiment or testing, and, while this honesty continues, the publicity of the use is not important. Egbert v. Lippman, 104 U. S. 333, 336, 26 L. Ed. 755; Elizabeth v. Pavement Co., 97 U. S. 126, 134, 24 I. Ed. 1000. It is probable that the use at bar was, at least in part,

and perhaps altogether, of this kind, but we prefer not to strain that aspect of the evidence. The word "public" means more than that the use shall not be experimental; it is possible, even after the time of experiment has passd, to practice the invention without abandonment. As inventor working by himself presents a simple case, but we cannot suppose that his rights are greater than those of a company. There must be some way by which they can privately practice their inventions as well as he, and yet any practice involves the knowledge of some employees. When the number of these is limited to as few as are necessary to practice it at all, when customers and the public generally are excluded, and adequate precautions are taken to prevent dispersion of the knowledge until at least two years before application is made, it seems to us enough, whether a formal pledge of secrecy be exacted or not. Those workmen who will keep it do not need it; those who will not, it will not bind. We do not mean that, if in fact knowledge leaks out, the invention may not be lost; as to that we say nothing. But when, as here, adequate means are taken to confine all information as closely as is consistent with any exploitation at all, and when, so far as appears, they are successful, the knowledge of the necessary workmen not explicitly pledged to security does not make the use public."

Emerson & Norris Co. v. Simpson Bros. Corp., C.C.A. 1st, 202 Fed. 747, and Brooks v. Sacks, C.C.A. 1st, 81 Fed. 403, held:

"This case, however, developed the underlying rule that ordinarily, in cases like the present, it is necessary that the anticipation should be supported, not merely by the testimony

of one or numerous witnesses relating to matters many years previous, but by concrete, visible, contemporaneous proofs which speak for themselves." "In that case (Brooks v. Sacks, 81 F. 403, C.C.A. 1st Circuit), the testimony of credible witnesses was rejected because there were no contemporaneous visible objects of that nature, and solely for that reason." The Court holds that "something more than oral testimony, even of the highest character, is required where there has been a considerable lapse of time."

CONCLUSION

It is respectfully urged that Petition for Writ of Certiorari be granted and decision of the Court below be reversed.

Respectfully submitted,

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West Palm Beach, Florida

September 8, 1953

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No. 377

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IN THE SUPREME COURT OF THE UNITED STATES

BENJAMIN ARTHUR BOURNE,

Petitioner,

versus

LUTHER JONES

Respondent.

BRIEF ON BEHALF OF RESPONDENT

R. Bruce Jones, of
EARNEST, LEWIS, SMITH & JONES
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